

**REMARKS**

In response to the Office Action dated on December 15, 2004:

Claims 1-5, 9-11, 14-15, and 17-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Peek, U.S. 6,614,551 in view of Parks et al., U.S. 5,877,746. This rejection is respectfully traversed.

**The Applicant's Object.** Applicant's independent claim 1, as amended, excludes a printer and a personal computer. Lacking a printer, it encourages users to view faxes on a PC display, after retrieving images files saved on a floppy disk, etc. (dependent claims 14-17), via a LAN (dependent claim 3), or some other way that does not use paper, thus meeting the Applicant's object (page 4, lines 2 and 8 of the specification). Because no PC is part of the claimed apparatus, it is as easy to use as a regular fax and no dedicated PC is needed, thus meeting other objects of the Applicant (page 4, lines 9-13).

**The Rejection.** In rejecting claim 1, the Office Action first points to Peek as disclosing a paperless image fax-scanning apparatus (FIG. 3, 100). The Office Action acknowledges that Peek fails to disclose a data storage unit, which can be connected to a portable data storage medium for storing the fax image data received by the faxing unit in the portable data storage medium, as the rejected claim 1 requires. However, the Office Action points to Parks et al as disclosing a data storage unit (disk 45), which can be connected (I/O connector 46) to a portable data storage medium for storing the image data received by the faxing unit in the portable data storage medium (FIG. 10, column 21, lines 10-30). The Office Action asserts that it would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the memory 120 would have an interface connected thereto to provide use of additional components such as a memory unit for overflow data and to have capabilities of other devices by uploading information stored for user's usage.

The Examiner points to Peek's control unit (processor 110) for controlling the operation of the image fax-scanning apparatus (FIG. 3, column 3, lines 48-5 and column 4, lines 5-10). However, FIG. 3 and the text of Peek referenced by the Office Action do not disclose, teach, or suggest a control unit for controlling the operation of the paperless

image fax-scanning apparatus, wherein the control unit transfers the fax image data received by the faxing unit to the data storage unit and stores the fax image data in the portable data storage medium, as amended claim 1 requires. In addition, Peek and Parks et al do not teach or otherwise suggest that **the paperless image fax-scanning apparatus excludes printing facilities that directly produce printout and is operable independently without control of a personal computer so as to save paper with the operation of the paperless image fax-scanning apparatus**, as claim 1 requires (emphasis added).

Peek discloses (Figs. 1 and 3) that a printer (46 or 146) is included in the apparatus (20 or 100).

Thus, it is respectfully submitted that the cited modification proposed by the Office Action does not arrive at the claimed invention, as amended claim 1 recites.

As set forth in MPEP section 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Besides, in determining obviousness, it is impermissible to pick and choose from any one reference only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

Applicant's claim 1 is directed to **a paperless image fax-scanning apparatus comprising an image scanning unit, a faxing unit, a data storage unit, an input interface, and a control unit**, where the paperless image fax-scanning apparatus **excludes printing facilities that directly produce printout and is operable independently**

**without control of a personal computer** so as to save paper with the operation of the paperless image fax-scanning apparatus. (emphasis added)

By contrast, what Peek discloses is **an email capable fax machine** that works as a fax machine, and is further capable of sending and receiving graphic data by email, rather than **a paperless image fax-scanning apparatus** to which the Applicant's application is directed. Fax machine 100 in FIG. 3 and the text referenced by the Office Action clearly discloses that the fax machine 100 preferably further includes **a fax type printer 146**. The received data, whether it is fax type data from another fax machine, or a graphics file that has been converted to fax data, is sent to the printer where it is printed as a fax message. (See SUMMARY OF THE INVENTION; column 2, lines 30-33; column 2, lines 61-65).

Further, what Parks et al disclose is **a method for interacting with a computer system** having a display unit, a processor, a memory and a Cartesian selection device so that non-computer savvy users will find easy to use, rather than **a paperless image fax-scanning apparatus that excludes printing facilities that directly produce printout and is operable independently without control of a personal computer, as Applicant's claim 1 requires**. FIG. 1 of Parks et al illustrates an all-in-one integrated office system 10 implementing the user interface of Parks et al. Although the user interface can be used with any number of integrated or stand-alone systems or devices, integrated office system 10 represents a preferred embodiment of the platform for the user interface since integrated office system 10 supports low-volume copying, faxing, scanning and **printing** of documents. In FIG. 2 of Parks et al, **printer mechanisms** of integrated office system 10 are described (column 6, lines 16-43). **The integrated office system 10 incorporates a general purpose personal computer**, preferably, a MACINTOSH personal computer. The circuitry and operation of such a computer is well known in the art, insofar as the personal computer is capable of running traditional application programs (column 27, lines 25-31). (emphasis added)

**No Combination, Even If Obvious (not admitted), Could Reach the Claims.**

As above discussed, both Peek and Parks et al references disclose a preferred embodiment to include printing facilities that directly produce printout. These disclosures

contrast with the main objective, among the others, of the Applicant's claimed invention to provide a **paperless** image fax-scanning apparatus that saves paper (see SUMMARY OF THE INVENTION of the Applicant's specification) with the operation of the paperless image fax-scanning apparatus. Both the cited references do not state such objective and do teach a way of integrating different function blocks including a printer, preferably. Thus, it is respectfully submitted that Peek and Parks et al do not teach, disclose, or suggest the exclusion of printing facilities that directly produce printout so as to save paper with the operation of the paperless image fax-scanning apparatus, as Applicant's claim 1 requires. Further, in contrast to a paperless image fax-scanning apparatus that **is operable independently without control of a personal computer**, Parks et al disclose the **integrated office system 10 incorporates a general purpose personal computer**. For at least these reasons, it is respectfully submitted that neither Peek reference nor Parks et al reference provides motivation or suggestion to one of ordinary skill in the art at the time of the invention to modify Peek so as to arrive at Applicant's claim 1.

Claims 12-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Peek, and Parks et al., in view of Matsuda et al., U.S. 6,055,067. Claims 6-8, 16, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Peek, and Parks et al., in view of Brusky et al., U.S. 6,487,611. These rejections are respectfully traversed on the grounds above. Withdrawal of the rejection is requested.

**New Claim 20.** New claim 20 recites the housing that is shown in the drawing. The housing emphasizes that the claimed apparatus is a stand-alone apparatus that, when connected to a telephone line, discourages printing and paper waste.

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Respectfully submitted,

Nick Bromer

Nick Bromer, Reg. No. 33,478  
RABIN & BERDO, P.C.  
CUSTOMER NUMBER 23995  
Telephone: 202-371-8976  
Facsimile: 202-408-0924